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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,200	09/04/2001	Anthony J. Bradshaw	001307.00057	2584

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EXAMINER	
LACYK, JOHN P	
ART UNIT	**PAPER NUMBER**
3736	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,200	BRADSHAW ET AL.	
	Examiner	Art Unit	
	John P. Lacyk	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 17-63 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 17-63 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 04/18/02.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 24,35,39,41,54 and 63 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for centering the radiotherapy lumen within the vessel, does not reasonably provide enablement for the longitudinally channeled, fluted, segmented or scalloped balloon being the means for the centering. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. On page 18, the specification states that segments or scallops may be used to permit flow by of blood. There is no teaching of using an inflatable balloon catheter having such segments to center the device or that the segments or scallops are critical to centering the device.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 17, 19, 21-24, 27-41, 44-45, 47, 54, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weikl (9102312.2) in view of Blackshear, Jr. et al (5,308,356).

Weikl discloses a method of treating the wall of a blood vessel by inserting a catheter into the vessel lumen until the balloon is adjacent the target, inflating the balloon to substantially center the radiotherapy lumen (Figure 2), advancing the radioactive source to the treatment region and withdrawing the source after a predetermined interval of time for the therapy. Weikl discloses the claimed method except for allowing perfusion of the blood past the inflated balloon through channels in the balloon. Blackshear, Jr. et al discloses a balloon catheter used for angioplasty and teaches that it is well known to provide a channeled balloon having grooves (36) to allow for the perfusion of blood past an inflated balloon catheter during the angioplasty procedure. Therefore a modification of the method of Weikl to include a perfusion path through channels in the balloon would have been obvious since this would allow the procedure to continue without being interrupted to deflate the balloon and allow blood to pass. The grooves are considered to also include channels, flutes and scallops, which are similar terms for the same structure. With respect to claims 21, 27, 32 and 59 to select any well known radioactive source with specific radiation dosages would have been obvious to one skilled in the art based upon the its suitability for the intended use. Since different radioactive sources are known to provide different doses and different areas of the body may need specific dose range to select the specific radiation material to provide a specific radiation dosage would have been obvious to one skilled in the art based upon which material would be more suitable for the intended use.

5. Claims 48, 51-53, 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weikl in view of Blackshear, Jr. et al as applied to claims above, and further in view of Van't Hooft et al (4,881,937).

Weikl in view of Blackshear, Jr. et al discloses the claimed method except for the use of an afterloader having a dummy wire to determine the proper placement of the radioactive wire. Van't Hooft et al teaches that it is well known to use such an afterloader having a dummy wire to aid in proper placement of the radioactive source. Therefore a modification of Weikl such that the device is used with an afterloader and dummy wire would have been obvious in view of the teachings of Van't Hooft et al.

6. Claims 20, 26, 42-43, 46,49-50, 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weikl in view of Blackshear, Jr. et al as applied to claims above, and further in view of Flexmedic article.

Weikl discloses the claimed method except for the guidewire for inserting the radioactive source being made from a super-elastic material. Flexmedics discloses the use of Nitinol which is a well known shape memory alloy that has superelastic properties and teaches that it is well known to use such a material with guidewires. Therefore a modification of Weikl such that the wire used to insert the radioactive source is made from Nitinol would have been obvious since this would have been the mere substitution of one well known guidewire material for another.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 60 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 10 of prior U.S. Patent No. 6,283,910. This is a double patenting rejection.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 18, 25, 61-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 3-5 of U.S. Patent No. 6,283,910 in view of Blackshear, Jr. et al. Although the conflicting claims are not identical, they are not patentably distinct in that the patented claims teach the claimed method except for specifically using a centering catheter having an inflatable centering balloon for blood flow and centering. Blackshear, Jr. et al, as discussed

above, teaches that it is well known to provide a catheter having channels to allow for blood to perfuse while the procedure is being performed so that the procedure does not have to be stopped to deflate the balloon to allow blood to pass. Therefore a modification of claim 1 to include a balloon catheter to allow blood to perfuse without stopping the procedure would have been obvious in view of Blackshear, Jr. et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk